

REMARKS

Claims 1-8, 23-29, and 35-41 are pending, with claims 1, 3, and 23 being independent. Reconsideration and allowance of the above-referenced application are respectfully requested.

Rejections under 35 U.S.C. § 103:

Claims 1, 3, 4, 6, 7, 23, 25, 28, 36, 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pub. No. 2005/0132083 to Raciborski et al. ("Raciborski") in view of U.S. Pub. No. 2003/0028899 to MacInnis et al. ("MacInnis"). Claims 5, 26, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pat. No. 5,586,260 to Hu. Claims 8, 27, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of U.S. Pat. No. 6,006,034 to Heath et al. ("Heath") and in further view of Hu. Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pat. No. 7,233,981 to Tenereillo et al. ("Tenereillo"). Claims 2, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pub. No. 2003/0135650 to Kano et al. ("Kano"). These contentions are respectfully traversed.

The Office's use of Raciborski as prior art is not proper since Raciborski's non-provisional patent application, as cited by the Office, was filed and published after the filing date of the instant application. In reply to this point, the Office has now provided copies of the three

provisional applications to which Raciborski's non-provisional patent application claims priority. However, in the rejections themselves, the Office continues to cite to Raciborski's non-provisional patent application, even though paragraphs to which the Office cites (e.g., paragraphs [0033] and [0037]) are not present in the three provisional applications. Thus, the Office has not met its burden of establishing that Raciborski can serve as a reference under 35 U.S.C. 103(a) for the portions cited therein.¹ For at least this reason, there is a clear legal or factual deficiency in all of the rejections based on Raciborski, and these rejections should be withdrawn.

Furthermore, the Office asserts that MacInnis teaches the presently claimed "...sending information specifying an acceptable authentication procedure; receiving an authentication procedure update request from the client in response to client processing of the information specifying an acceptable authentication procedure ..." in paragraph [0012] of MacInnis.² However, the Office admits that MacInnis does not teach a request for descriptors being received from the client, and goes on to suggest that this would be obvious in view paragraph [0007] in MacInnis, which describes downloading schemes involving client-server paradigms.³ However, paragraph [0007] in MacInnis is in the background section and is describing prior art that MacInnis explicitly discourages using. Rather, the explicit objective in MacInnis is to not have the client need to send a request:

The present invention solves the aforementioned problems by providing a system and method for selectively downloading software and data modules to terminals in a network without requiring communication between the terminal and the downloading source.⁴

¹ See MPEP 706.02(f)(1)(I)(B) and MPEP 2136.03(III).

² See 6-3-2010 Office Action at pages 7-8.

³ See 6-3-2010 Office Action at page 8.

⁴ See MacInnis at ¶ [0011].

Thus, MacInnis actually teaches away from the combination proposed by the Office, and the proposed combination cannot be made to render the claimed subject matter unpatentable.

In reply to these points, the Office now states, "As modified, the pertinent problem of downloading source versions based on client capabilities, as per MacInnis, is applied to a network presented in Raciborski."⁵ Thus, the Office has acknowledged that the rejection relies upon a modification by the Office of the teachings of MacInnis. Therefore, an aspect of the claimed subject matter has not been identified in the prior art. In addition, the Office states:

Although the field of endeavor in MacInnis, as applied to television subscription systems, avoids implementing two way communications, a skilled artisan would appreciate the applicability of the download scheme presented in MacInnis is applicable to networks configured to support content object download requests.⁶

Thus, the Office has acknowledged that the proposed modification of MacInnis is inconsistent with the teachings of MacInnis itself. Therefore, MacInnis teaches away from the combination proposed by the Office. For at least this reason, there is a clear legal or factual deficiency in all of the rejections based on MacInnis, and these rejections should be withdrawn.

Furthermore, in order to reject the claimed subject matter, the Office continues to treat the download manager of Raciborski as equivalent to an authentication procedure.⁷ The Office further notes that there will be different versions of the download manager for different client computer systems, and the Office concludes that it would have been obvious to provide an appropriate client-compatible version of the download manager to the client.⁸ However, this fails to consider the claimed subject matter as a whole. Claim 1 is clearly directed to providing

⁵ See 6-3-2010 Office Action at page 3.

⁶ See 6-3-2010 Office Action at page 3 (emphasis added).

⁷ See 6-3-2010 Office Action at page 4 and 11-27-2009 Office Action at page 15.

⁸ See 6-3-2010 Office Action at pages 6-8.

an appropriate program to a client to authenticate a user based on a document being accessed by the user and the action requested with respect to that document. Raciborski describes a system for downloading a plurality of content objects from the Internet to a computer of a user.⁹ MacInnis describes a system for downloading different versions of software or data modules into a plurality of terminals having different compatibility interfaces.¹⁰ Neither of these references are directed to controlling access to a document by sending information specifying an acceptable authentication procedure after determining whether user authentication is needed based on the document identifier and the action.

In response to these points, the Office notes that “in response to the user selecting a content object (e.g., identifier such as audio, video) for download (action), a download manager implementing a password interface is downloaded ([0037]) (e.g., authentication procedure).”¹¹ Thus, the Office acknowledges that the download manager (the alleged software program effecting the authentication procedure) is obtained in response to selection of the content object (the alleged document). However, the claim language specifies that the software program is obtained “in response to the authentication procedure update request”, which is clearly different than being in response to a request from the client to take an action with respect to the document. Thus, the claim language does not read on the proposed combination.

Moreover, the Office further notes that upon “a successful download of the manager, as modified, it is obvious that this program may become outdated. In response, a client will request an updated version for the download manager software but only after processing the information

⁹ See Raciborski at Abstract.

¹⁰ See MacInnis at Abstract.

¹¹ See 6-3-2010 Office Action at page 4.

specifying an acceptable authentication procedure (e.g., best program for download)[.]”¹² Thus, the basis for the rejection is that there may be older and newer versions of the download manager, of which the client is informed, and the client picks the version that is most compatible with the client. However, this notion of picking a download manager based on compatibility with the client is completely disconnected from the claimed subject matter, which is directed to controlling access to a document by sending information specifying an acceptable authentication procedure after determining whether user authentication is needed based on a document being accessed by the user and the action requested with respect to that document, and sending software to effect the authentication procedure when requested to do so by the client that received the information specifying an acceptable authentication procedure. The proposed (modified) combination of references fails to teach this subject matter because providing a program based on compatibility with a client device on which the program is to run is not the same as providing a program based on an identified document at a client and an action to be taken with respect to that identified document.

For all of the above reasons, independent claim 1 should be in condition for allowance. Neither Hu, Heath, Tenereillo nor Kano cure the noted deficiencies of Raciborski and MacInnis. Thus, dependent claims 2 and 4-8 should be allowable based on the above arguments and the additional recitations they contain.

Independent claim 3 recites, “receiving, at a server, a request from a client to take an action with respect to an electronic document; obtaining, at the server and in response to the request, a software program comprising instructions operable to cause one or more data

¹² See 6-3-2010 Office Action at page 4.

processing apparatus to perform operations effecting an authentication procedure; sending the software program to the client for use in identifying a current user and controlling the action with respect to the electronic document based on the current user and document-permissions information associated with the electronic document; receiving an updated authentication procedure; receiving a subsequent request from the client to take the action with respect to the electronic document; obtaining, at the server and in response to the subsequent request, a new software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting the updated authentication procedure; and sending the new software program to the client for use in identifying the current user and controlling the action with respect to the electronic document based on the current user and the document-permissions information associated with the electronic document."¹³ Thus, independent claim 3 should be in condition for allowance for at least reasons similar to those addressed above with respect to claim 1.

Independent claim 23 recites, "a client that sends an authentication procedure update request to a server in response to client processing of information received from the server, wherein the information received from the server specifies one or more acceptable authentication procedures; the server that receives the authentication procedure update request, and in response to the client, the server obtains and sends a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting an authentication procedure; and wherein the client uses the software program to identify the current user and control an action with respect to an electronic document based on the current user and document-

¹³ Emphasis added.

permissions information associated with the electronic document, and wherein the action comprises an action taken with respect to the electronic document subsequent to opening the electronic document at the client.”¹⁴ Thus, independent claim 23 should be in condition for allowance for at least reasons similar to those addressed above with respect to claim 1. In addition, it is noted that the Office has provided no explanation of what in the art is considered to be “an action taken with respect to the electronic document subsequent to opening the electronic document at the client”, as required by the claim. Thus, there is a clear legal or factual deficiency in the rejection of claim 23 for at least this additional reason. Moreover, dependent claims 24-29 and 35-41 should be allowable based on the above arguments and the additional recitations they contain.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

A formal notice of allowance is respectfully requested. Absent this, a telephone interview with the Examiner and the Examiner's supervisor is respectfully requested.

¹⁴ Emphasis added.

Applicant : Jonathan D. Herbach, et al.
Serial No. : 10/699,165
Filed : October 31, 2003
Page : 14 of 14

Attorney's Docket No.: 07844-0623001 / P568

Please apply any necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: Aug. 3, 2010

William E. Hunter
William E. Hunter
Reg. No. 47,671

Customer Number 21876
Fish & Richardson P.C.
Telephone: (858) 678-5070
Facsimile: (877) 769-7945